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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 2003-0372 / 24061.93

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on 3-21-11

Signature Bonnie Boyle

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Application Number	Filed
10/821,016	April 8, 2004

First Named Inventor: Hsiao-Wen Wan

Art Unit	Examiner
2444	Peling A. Shaw

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [x] attorney or agent of record. Registration number 37,713
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

Signature

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214-651-5000
Telephone number

3/21/11
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [ ] *Total of one forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Hsiao-Wen Wan, et al.	§	Docket No.:	24061.93 / 2003-0372
Serial No.:	10/821,016	§	Examiner:	Peling A. Shaw
Filed:	April 8, 2004	§	Art Unit:	2444
For:	Method for Circulating a Report in a Semiconductor Manufacturing Environment	§	Conf. No.:	9310

REASONS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

I. INTRODUCTION

The present paper is being filed under the Official Gazette Notice of July 12, 2005, and in response to the final Office action mailed December 20, 2010, and the Advisory Action mailed February 8, 2011, in connection with the above-noted application. A Notice of Appeal with the proper fee is being filed concurrently with this paper. It is assumed that no additional fees are required, but if any additional fees are required, the Commissioner is hereby authorized to charge any fees, including those for any extensions of time, to Haynes and Boone, LLP's Deposit Account No. 08-1394.

II. REASONS

In the final Office action mailed December 20, 2010, claims 1-5, 7, 10-14, 16 and 19-23 were rejected under 35 U.S.C. 102(b) as being anticipated by Lu et al., "B2B in TSMC Turnkey Services" (hereinafter "Lu") and claims 6, 8-9, 15, 17-18, and 24-26 were rejected under 35 U.S.C. §103 as being unpatentable over Lu in view of U.S. Patent No. 6,363,414 to Nicholls et al. (hereinafter "Nicholls"). . Applicants submit that the Examiner has made clear errors in rejecting the claims.

A. Rejections Under 35 U.S.C. § 102

In particular, claim 1 requires *inter alia*:

selecting at least one of a plurality of input files;

selecting an output file format from a plurality of output file formats;

selecting a mode for circulation from a plurality of modes for circulation; . . . and

circulating the output file to at least one recipient entity using the selected mode for circulation.

1. *selecting at least one of a plurality of input files*

The Examiner cites the third paragraph on the left column of page 41 and the fifth paragraph on the right column of page 41 of Lu as disclosing "selecting at least one of a plurality of input files." Those paragraphs are reproduced below for ease of reference:

> *At first, the target was providing the integrated WIP, including WIP in FAB, circuit probing (CP), assembly and final test, yield data and ship alerts to customers. In this period, it produced some kinds of data to ask the subcontractors to provide. These data included electronic purchase orders (e-PO), the confirmed shipping dates from subcontractors (SOD), the lots in the subcontractors'' factories (WIP), the transaction of entering inventory (named INSLIP), the lots in subcontractors' finished goods (named FG Bank) and the shipping information (named SHIPOUT). . . .*

> *After developing the phase I and phase II, there is now a proper B2B architecture. But there is still something missing before the system becomes a real B2B system. What is the real B2B system? it must integrate the information, material and cash flows. After phase II was released, it didn't integrate the cash flow into the system. It used the work order and the INSLIP data to make payments automatically. And at the same time, it didn't provide proper data for CRM, SCM and ERP. For these 2 reasons, there are 2 modifications to the system design.*

As has been previously noted, the cited text reproduced above teaches, at best, entry of INSLIP data (i.e., data entry), which is clearly not equivalent to selecting at least one of a plurality of input files. In particular, no selecting of any sort of file is taught, much less selection of one of a plurality of input files as recited in claim 1.

In section 9.b. of the "Response to Arguments" portion of the final Office action, the Examiner states that "the limitation of 'selecting' is suggested as an implementation of intended application similar to what is described in the quoted section of LU" (emphasis added). Applicants respectfully disagree. Once again, the Examiner has failed to, and Applicants submit that he cannot, state unequivocally that Lu discloses "selecting at least one of a plurality of input files" as recited in claim 1. Instead, the Examiner again resorts to words like "similar." As has been previously noted, rejections of claims must be unequivocal (*see* MPEP 706.02 and 707.07(d)). As one of ordinary skill in the art would no doubt recognize, there is a marked difference between enabling a user to enter data into a system and enabling a user to select an input file from a plurality of input files.

2. *selecting an output file format from a plurality of output file formats*

The Examiner cites the final paragraph on page 43 through the first paragraph on page 44 of Lu as disclosing "selecting an output file format from a plurality of output file formats." That paragraph is reproduced below to facilitate discussion:

> *Originally, subcontractor will inform TSMC when the lot was finished though e-mail, phone or FAX. After getting the information, TSMC could send a shipping instruction to subcontractors and a shipping alert to customers through FAX. The new system changes the flow of shipment. When subcontractors complete the lot, they will send an INSLIP transaction to TSMC. After receiving the INSLIP transaction, the system will processes [sic] some checks to make sure the said good is ready for shipping automatically. If the lot is ready, then the system will send a shipping instruction through a XML format to the subcontractors and a shipping alert to the customer through e-mail. The new flow could reduce by at least 2 days the time from lot finish to shipment, auto issue shipping instructions instead of FAX and auto issue sipping alerts to Customer instead of FAX.*

(emphasis added).

As has been previously noted, the cited text, reproduced above, teaches sending data in a single predetermined format (i.e., XML format); it clearly fails to teach enabling selection of an output file format from a plurality of available formats. Even assuming *arguendo* that the cited text teaches the existence of multiple output file formats, it still fails to teach allowing a user to select from among those formats; rather, the format of the output file of Lu is not described by Lu as being configurable or selectable.

3. *selecting a mode for circulation from a plurality of modes for circulation* and *circulating the output file to at least one recipient entity using the selected mode for circulation*

The same paragraph of Lu is cited as teaching "selecting a mode for circulation from a plurality of modes for circulation . . . and circulating the output file . . . using the selected mode for circulation." Once again, the cited text teaches only a single mode for circulation (i.e., e-mail); it clearly fails to teach selection of a mode from a plurality of modes and then circulating the output file using the selected mode, as recited in claim 1. It will be noted that the reference to FAX transmission is in the context of a prior art system; in other words, in the "old" system, shipping alerts were FAXed to customers; in the "new" system, shipping alerts are emailed instead of FAXed. Neither system described in the referenced paragraph enables a user to select one or the other modes of forwarding shipping alerts; only one option is available in each system. Therefore, the cited paragraph clearly fails to teach "selecting a mode for circulation from a plurality of modes for circulation," as recited in claim 1.

In summary, the system of Lu circulates data in a predetermined, fixed, and non-selectable output file format via a predetermined, fixed, and non-selectable mode of communication. Clearly, such a

system is not anticipatory of the system clearly recited in claim 1. In view of the foregoing, it is apparent that Lu fails to anticipate claim 1 and the subject rejection should therefore be withdrawn. Independent claims 10 and 19 include limitations similar to those of claim 1 in this regard and is therefore also deemed to be allowable over Lu. Claims 2-5, 7, 11-14, 16, and 20-23 depend from and further limit claims 1, 10, and 19, respectively, and are therefore also deemed to be in condition for allowance for at least that reason.

B. Rejections Under 35 U.S.C. § 103

With regard to claims 6, 8-9, 15, 17-18, and 24-26, Applicants submit that, in view of the fact those claims depend from and further limit independent claims 1, 10, and 19, the claims are deemed to be in condition for allowance for at least that reason.

III. CONCLUSION

In view of the fact that there are clear errors in the Examiner's position, as demonstrated above, it is apparent that the rejection of the pending claims under 35 U.S.C. §102 and §103 is not supported by the references and should therefore be withdrawn. Accordingly, all of the pending the claims in the application being in condition for allowance, such action is respectfully requested.

Respectfully submitted,

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